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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,233	11/18/1999	JOHN A. HELGENBERG	TN167	6933

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/443,233

Applicant(s)

Helgenberg

Examiner

Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See: 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 26, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8, 14, 15, 19, and 22-25 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 14, 15, 19, and 22-25 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph since it cannot be determined what is meant by the limitation of "mounted on said door adjacent a surface of said door" and because there is confusion as to whether "[positioned]" is intended to be in the clean copy of the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8, 14, 19, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,39,113 to Goss.

Goss '113 teaches Applicant's claim limitations including : a "stud" - 12, "extending outwardly from one of said structures" - from 1, "having an outer surface oriented at an angle to

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“said axis” - as shown on the face of the patent, a “resilient member” - 28, “positioned adjacent a surface of the other one of said structures” - as shown, “torroidal configuration” - as shown.

As shown in Fig 8 for example, the resilient member (28) is engaging an outer surface of said stud. One of ordinary skill in the art would recognize that the gap between the stud and part 14 as viewed in Fig 8 for example is large enough to permit entry of any of various tools that can be used to compress the resilient member and allow release of the stud whereby the structure of the reference is *inherently* “releasable” or ‘capable of being released’. Inasmuch as this is a product claim, defined by its structure and not a ‘process of using’; there is no requirement that an anticipatory reference teach steps in some intended use of the product. See MPEP 2173.06(p) section II as regards product and process of using in the same claim. See MPEP 2114 as regards functional language.

Inasmuch as a *capability* is recited and not any particular structure, the limitation is broad. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, there is no indication that any structure is claimed in accordance with 35 USC 112, 6th paragraph that might be relied upon to patentability define from structure of the reference. See MPEP 2181-2185.

Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). It is the examiner’s position that the reference teaches all claim limitations. The law of anticipation requires that a distinction be made between

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the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

As regards claim 4, since the various functional recitations aren't exclusively related to a single position of the claimed elements, the structural elements of the reference reads directly on all limitations as shown in Fig's 6-8.

As regards claim 8, part 28 inherently has spring properties in the radial directions and reads on broad limitation of "radial spring". Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*. 181 USPQ 641 (CCPA 1974). Accordingly, it is suggested that the limitation be amended as --a coiled metal spring with its central axis arranged in a circle to form said torroidal configuration--.

As regards claims 24 and 25, Goss '113 discloses the stud to be mounted on the "door" (1) where parts including 22 read on broad limitation of "frame".

5. Claims 1-3, 6-8, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,577,507 to Bergdoff.

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Bergdoff '507 teaches Applicant's claim limitations including: a "stud" - including 16, "extending outwardly from a first one of said structures" - the illustrated door, a "resilient member" - 14, "second structure" - including 18.

As regards claim 3, the door (23) of the reference reads on broad limitation of "frame" which is not otherwise structurally defined.

6. As best understood, claims 1-8, 14, 15, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,154,308 to Larson.

Larson '308 teaches Applicant's claim limitations including: a "stud" - including 80,86, "extending outwardly from a first one of said structures" - including 18,40, a "resilient member" - 109, "second structure" - including 22,96.

As regards claim 4, parts including 18,40 read on broad limitation of "door".

As regards claim 15, as shown in Fig 3, the "stud" is mounted on the "frame" (including part 50) and the "radial spring" (109) is "mounted on the door" (18) "adjacent a surface of the door", where 'adjacent' is broad and does not require contact.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. As best understood, claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,639,113 to Goss.

Although Goss '113 discloses the stud to be mounted on the "door" (1), it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art to simply reverse the parts, mounting stud (1) on part 3 and provide the opening or the stud on part 1 since it would not affect the function of the device and it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Whether or not the stud is mounted on part 1 or 3, of the reference, limitation of "radial spring positioned adjacent a surface of said door" is broad since the term "adjacent" is broad and does not require direct contact or specify any particular distance, etc..

The proposed modification does not otherwise affect the function of the device and would be recognized by one of ordinary skill in the art as being equivalent for those reasons. Furthermore one of ordinary skill in the art would have more than a reasonable expectation of success, especially considering the high level of skill in the art which includes degreed engineers with extensive knowledge of prior art, manufacturing, structural analysis and materials science. See MPEP 2144.04, section VI. The examiner notes there does not appear to be any 'criticality' of position on one, and not the other structure.

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Response to Arguments

9. Applicant's arguments with respect to the pending claims have been considered but are not persuasive and/or are moot in view of the new ground(s) of rejection.

As previously noted, the scope of the present claims has been carefully examined and is considered broad in view of the prior art which teaches the broad structural limitations of 'door', 'frame', 'stud' and 'resilient member' used for releasable engagement. Any further structural limitations for these elements are broad and/or lacking whereby reasonable interpretation might include many diverse well known 'systems for engagement'. For example, limitation of substantially toroidal resilient member might be read on well known rubber O-rings used to obtain a releasable engagement between two structures.

Reliance on functional recitations to patentably distinguish in this crowded art is misplaced. While functional language can be used to further define a claimed element, the result may be open to broad interpretation since actual structure is not defined. See MPEP 2114. That is the case now. Inasmuch as Applicant seeks exclusive rights to the claimed invention, it seems reasonable to expect the product claims to define structure of that product that patentably distinguishes the present invention from structure of products that are old and well known in the art.

In accordance with their plain meaning, the present functional recitations cannot and should not be interpreted or given weight as method steps in a process of using. Regardless. Applicant's attention is directed to MPEP 2173.06(p) section II as regards product and process of

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using in the same claim. Present functional recitations may most nearly be related to the claimed product as regards *intended use* of the product. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Lastly regarding functional language, it is noted that the functional recitations should not be confused or otherwise interpreted as covering disclosed structure in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185. To the contrary, claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

As regards the Vyse '031 reference, the examiner does not concede that it is impossible to release the structures of that reference, but since that does not appear to be the intention of the reference, the rejection is withdrawn in favor of a new grounds of rejection that better reflects the changed scope of the claims and will hopefully advance prosecution. Regardless, the examiner

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notes that the Vyse '031 reference explicitly discloses releasable connections are well known in the "Field and Background" portion of that disclosure and lists several patents related thereto.

As regards Goss '113, the broadness of the "releasable" limitation is relied upon in the grounds of rejection. The explicitly-disclosed gap between the structures would inherently allow a tool to be inserted for manipulating the resilient member and releasing the structures. One of ordinary skill in the art would recognize that capability. The "releasable" limitation is broad, and contrary to Applicant's arguments, has not defined over the inherent features of the prior art for the reasons noted. The present limitation does not define any structure which can be relied upon to patentably distinguish from the prior art. The "releasable" limitation specifies no particular structure as part of the invention and for that reason, does not exclude any particular structure from reading on the limitation so long as it has the 'capability' of being 'released', whether that capability is explicit or implicit. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

As regards prima facie case of obviousness in view of Goss '113, the examiner has relied upon the teachings of the reference, knowledge of those of ordinary skill in the art, and explicit direction of MPEP 2144.04 in establishing a prima facie case for obviousness in recognition of applicable case law that is consistent with Office policy.

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Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or

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amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

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13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.
- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

February 11, 2003



GARY ESTREMSKY
PRIMARY EXAMINER